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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,929

02/17/2005

Petri Kokkonen

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EXAMINER

EWART, JAMES D

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,929

Applicant(s)

KOKKONEN ET AL.

Examiner

James D. Ewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 22, 2003 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed March 22, 2007 have been fully considered by the Examiner and they are persuasive, however the Examiner found a related application of applicants prevailing a double patenting rejection. The application will be allowed after the filing of a terminal disclaimer.
2. Regarding the 35 USC § 112 rejection, Applicant's amendment has overcome the rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claim 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-60 of copending Application No. 10/495,275. Reasoning for nonstatutory double patenting is as follows:

Claims 31 & 32 of application 10/495,275 include all the limitations of the independent claims and both sets of claims teach communicating data associated with provisioning of the requested service to the mobile user equipment (i.e. GPS assistance data) over an active user plane connection (using an IP address) in response to a request for location of the mobile user equipment from a location service entity ((Location Application (LA))). The difference between the two applications is application 10/518,929 checks to see whether an active user plane address / IP address already exists and if it does sends the data via the existing user plane. The difference is sort of like trying to set up a voice traffic channel to send the data prior to checking to see if the user is on a current traffic channel. However, being that packet data is intermittent, it would be feasible to send the GPS assistance data over an existing IP address rather than interrupting a voice call to send the assistance GPS data.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

4. Claims 1-19 are rejected based on a provisional double patenting rejection, but would be allowable after submission of a terminal disclaimer. The reason for allowable subject matter is provided below:

Referring to claims 1,12 and 19, the references cited do not teach a method of communicating information, the method comprising: storing in a storage module, information about possible associations between an identifier of a mobile user equipment and user plane addresses, wherein the user plane addresses are associated with active_user plane connections; receiving at a service provisioning entity a request for the service from a client connected to a communication system, said request including the identifier of the mobile user equipment; verifying if a user plane address can be found from the storage module based on the identifier and if the user plane address is found from the storage module, verifying whether an associated user plane_connection is active; and if such a user plane address is found from the storage module, communicating data associated with provisioning of the requested service to the mobile user equipment over an active user plane connection associated with said address found from the storage module ; and if no user plane address can be found from the storage module based on the identifier, establishing a new user plane connection and communicating data associated with a provisioning of the requested service to the mobile user equipment over said established user plane connection, and thereby providing the provisioning of the service in the communication system. Both Bloebaum (U.S. Patent 6,535,815) and Kingdon et al. (U.S. Patent No. 6,411,811) teach communicating data associated with provisioning of the requested service to the mobile

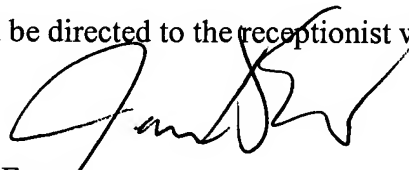
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user equipment (i.e. GPS assistance data) over an active plane connection (using an IP address) in response to a request for location of the mobile user equipment from a location service entity ((Location Application (LA))). Carlsson et al (U.S. Patent 6,603,978) teaches sending GPS assistance data over an existing user plane, but this is only done when the mobile station has a traffic channel established and a control channel is used when the traffic channel is not established. The traffic channel is used to send the GPS assistance data because there is no other means to send it to the mobile station and the reference does not teach setting up a traffic channel to send the data. Krasner teaches sending GPS assistance data via a communication link, but the communication link is not a user plane link.

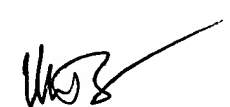
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.



James Ewart
April 24, 2007



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600